

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	86306250
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 110
<b>MARK SECTION</b>	
<b>MARK</b>	http://tmng-al.uspto.gov/resting2/api/img/86306250/large
<b>LITERAL ELEMENT</b>	THE BREAKFAST SHOPPE
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>ARGUMENT(S)</b>	
Please see the actual argument text attached within the Evidence section.	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_96234200208-20160610142548132946_. Request for Reconsideration_061016.pdf</a>
<b>CONVERTED PDF FILE(S)</b> (2 pages)	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\062\86306250\xml19\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\062\86306250\xml19\RFR0003.JPG</a>
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_96234200208-20160610142548132946_. Exhibits A and B.pdf</a>
<b>CONVERTED PDF FILE(S)</b> (10 pages)	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\062\86306250\xml19\RFR0004.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\062\86306250\xml19\RFR0005.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\062\86306250\xml19\RFR0006.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\062\86306250\xml19\RFR0007.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\062\86306250\xml19\RFR0008.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\062\86306250\xml19\RFR0009.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\062\86306250\xml19\RFR0010.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\062\86306250\xml19\RFR0011.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\062\86306250\xml19\RFR0012.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\062\86306250\xml19\RFR0013.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	1. Argument in support of registration. 2. Exhibit A - Declaration and Exhibit B - Third party registrations
<b>SIGNATURE SECTION</b>	

<b>RESPONSE SIGNATURE</b>	/Dominic J. Souza/
<b>SIGNATORY'S NAME</b>	Dominic J. Souza
<b>SIGNATORY'S POSITION</b>	Attorney of Record, Maryland Bar Member
<b>SIGNATORY'S PHONE NUMBER</b>	410-571-8366
<b>DATE SIGNED</b>	06/10/2016
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Fri Jun 10 14:43:59 EDT 2016
<b>TEAS STAMP</b>	USPTO/RFR-XX.XXX.XXX.XXX- 20160610144359857454-8630 6250-5504579bfed5866f3e0b d331565039f718b4b9edff27f d948a96fb30cde54e6c-N/A-N /A-20160610142548132946

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PTO Form 1960 (Rev 10/2011)  
OMB No. 0651-0050 (Exp 07/31/2017)

## Request for Reconsideration after Final Action

### To the Commissioner for Trademarks:

Application serial no. **86306250** THE BREAKFAST SHOPPE(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86306250/large>) has been amended as follows:

### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

Please see the actual argument text attached within the Evidence section.

### EVIDENCE

Evidence in the nature of 1. Argument in support of registration. 2. Exhibit A - Declaration and Exhibit B - Third party registrations has been attached.

#### Original PDF file:

[evi\\_96234200208-20160610142548132946\\_.Request\\_for\\_Reconsideration\\_061016.pdf](#)

#### Converted PDF file(s) ( 2 pages)

[Evidence-1](#)

[Evidence-2](#)

#### Original PDF file:

[evi\\_96234200208-20160610142548132946\\_.Exhibits\\_A\\_and\\_B.pdf](#)

#### Converted PDF file(s) ( 10 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /Dominic J. Souza/ Date: 06/10/2016

Signatory's Name: Dominic J. Souza

Signatory's Position: Attorney of Record, Maryland Bar Member

Signatory's Phone Number: 410-571-8366

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86306250

Internet Transmission Date: Fri Jun 10 14:43:59 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XXX.XXX.XXX-201606101443598

57454-86306250-5504579bfed5866f3e0bd3315

65039f718b4b9edff27fd948a96fb30cde54e6c-

N/A-N/A-20160610142548132946

In response to the Final Office Action refusing registration, Applicant argues the following:

**1. The Mark is not Generic**

The term “The Breakfast Shoppe” is not generic for catering services.

The Examining Attorney determined that “The Breakfast Shoppe” is generic for catering service by reviewing sources beyond the identification of goods and services contained in the application to define the genus of the services involved. By incorporating services for which registration is not sought, the Examining Attorney found that the mark is generic.

The Examining Attorney cites two cases in her Office Action, *In re Reed Elseveir Props, Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) and *In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005) for the proposition that “where an applicant’s website or other competent evidence shows that applicant’s goods and/or services are offered in connection with other interrelated goods and/or services not in the identification, those goods and/or services should be considered when determining the particular genus.” Office Action dated 12/11/16.

The cases cited by the Examining Attorney are easily distinguished from the case at issue. In both *In re Reed* and *In re DNI Holdings*, the goods and services that the applicants were attempting to exclude from the applications were “inextricably intertwined” to the point that even the services included in the application still incorporated the services that rendered the mark generic.

Where the goods and services are separate and distinct, it is not appropriate to define the genus of Applicant’s applied for services by directly incorporating non-claimed services present on its website. “[A] proper genericness inquiry focuses on the description of services set forth in [the application or] certificate of registration.” *In re DNI Holdings, supra*; see also *Magic Wand Inc., v. RD Inc.*, 940 F.2d 638, 640 (Fed. Cir. 1991); *In re Steelbuilding.com*, 415 F.3d 1293, 1298 (Fed. Cir. 2005).

In this case, Applicant’s catering services are separate and discreet from its restaurant services. Each portion of Applicant’s business could exist independently. A customer of the restaurant may be completely unaware that the catering service is provided, and a catering customer may never see the restaurant. The catering portion of Applicant’s business targets corporate customers, unlike the restaurant, and the catering menu is separate and distinct on Applicant’s website. Rather than being inextricably intertwined, these services are completely separate. The genus of Applicant’s goods for purposes of the application is therefore limited to the identification of goods and services on the application - catering. Using catering as the genus in the two part test set forth in *H. Marvin Ginn v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987 (Fed. Cir. 1986), the mark is not generic.

**2. The Mark is not Merely Descriptive**

Applicant reserves the right to argue that “Breakfast Shoppe” is not merely descriptive in the context of the amended application. With the more narrow goods and services description, “The Breakfast Shoppe” is much less, if at all, descriptive. If the mark is found descriptive, the previously filed 2(f) claim of exclusive and continuous use for 5 years is sufficient to show acquired distinctiveness. Nonetheless, Applicant submits the attached Declaration as further evidence of acquired distinctiveness, attached hereto and incorporated herein as Exhibit A.

### 3. Additional Third Party Registrations that Support Applicant's Registration

In further support of registration, and to supplement the list of third party registrations submitted with Applicant's prior Response to Office Action of October 26, 2015, the following trademark registration certificates are attached hereto and incorporated herein as Exhibit B to this Request for Reconsideration.

Trademark	Registration	Summary of Goods and Services
Corner Bakery Cafe	2597050	Restaurant, catering and bakery services
Corner Bakery Café Catering	4788481	Catering services
Corner Bakery Café	4802068	Retail Bakery Services
The Container Store	1164143	Retail store services in the area of household accessories, storage items, storage systems and space organizers.
The Fly Shop	1481139	Retail store and mail order services in the field of fishing equipment
The Body Shop	2256604	Retail store services and mail order catalog services for cosmetic, toiletries, skin care preparations and hair care preparations, etc.

## EXHIBIT A

**DECLARATION OF**  
**JEFFREY EDWARD FITCHETT**

Application Serial Number: 86306250

Mark: The Breakfast Shoppe

Applicant: Business Building Solutions, LLC

I, **Jeffrey Edward Fitchett**, declare under penalty of perjury as follows:

1. I am over the age of eighteen and competent to make this Declaration.
  2. The facts stated in this Declaration are within my personal knowledge and are true.
  3. I am the Managing Member of Applicant of record for the above-referenced trademark "The Breakfast Shoppe" (the "Application").
  4. The Applicant offers the services identified in the Application, of which I am the Founder and Managing Member. "The Breakfast Shoppe" is used only with my permission and under my control.
  5. The Applicant (through it and its various predecessors in interest) has been using "The Breakfast Shoppe" as a trademark for my restaurant and catering services continuously and exclusively for at least 27 years, since at least as early as January 1, 1988.
  6. The Breakfast Shoppe is now a very well known and popular restaurant Severna Park, Maryland and the purchasing public has come to recognize "The Breakfast Shoppe" as a trademark for my restaurant services.
  7. The Breakfast Shoppe is now a very well known and popular caterer in Maryland and the purchasing public has come to recognize "The Breakfast Shoppe" as a trademark for my catering services.
  8. Our annual sales over the last five years have averaged \$1,250,000.00 per year.
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9. We have reduced our advertising efforts over the last few years because public recognition, word of mouth promotion and positive reviews on the internet and in local publications, as well as positive professional food critic reviews in magazines and publications such as Rachel Ray's Food Magazine, WBAL TV Baltimore, The Splendid table national radio show and The Baltimore Sun have replaced the need to market. However, in the past we have spent an average of \$3,500.00 per year on advertising. The Breakfast Shoppe Facebook page has received over 14,000 hits since it was started in June 2010 and includes almost 5,000 favorable reviews.

10. West County Best of Food, Dining and Entertainment 2014 award for best breakfast – What's Up Annapolis.

11. Severna Park Voice Newspaper – Best Brunch, Capital Gazette – Best Breakfast, Zagat rated 4 consecutive years, Member BBB Accredited Business

12. As a result of the above-described professional recognition, media attention, promotional efforts, and my exclusive use of the mark for nearly thirty years, consumers and users of the relevant services understand "The Breakfast Shoppe" to identify the source of the services I offer under the mark.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that all statement made of his own knowledge are true and that all states made on information are believed to be true.

  
Jeffrey Edward Fitchett

Managing Member/Owner of Business Building Solutions, LLC

Date: 6/10/16



## EXHIBIT B

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

**United States Patent and Trademark Office**

Reg. No. 2,597,050

Registered July 23, 2002

**SERVICE MARK  
PRINCIPAL REGISTER**

**CORNER BAKERY CAFE**

BRINKER RESTAURANT CORPORATION (DE-  
LAWARE CORPORATION)  
6820 LBJ FREEWAY  
DALLAS, TX 75240

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "BAKERY CAFE", APART FROM  
THE MARK AS SHOWN.

FOR: RESTAURANT, CATERING, AND BAKERY  
SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).

SEC. 2(F) AS TO "CORNER".

FIRST USE 4-0-1999; IN COMMERCE 4-0-1999.

SER. NO. 76-112,166, FILED 8-18-2000.

OWNER OF U.S. REG. NOS. 2,078,299 AND  
2,145,582.

SAMUEL E. SHARPER JR., EXAMINING ATTOR-  
NEY

# United States of America

United States Patent and Trademark Office

## CORNER BAKERY CAFE CATERING

**Reg. No. 4,788,481**

**Registered Aug. 11, 2015**

**Int. Cl.: 43**

**SERVICE MARK**

**PRINCIPAL REGISTER**

CBC RESTAURANT CORP. (DELAWARE CORPORATION)  
12700 PARK CENTRAL DRIVE, SUITE 1300  
DALLAS, TX 75251

FOR: CATERING SERVICES, IN CLASS 43 (U.S. CLS. 100 AND 101).

FIRST USE 4-0-1999; IN COMMERCE 4-0-1999.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,597,050, 2,679,615 AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BAKERY CAFE CATERING", APART FROM THE MARK AS SHOWN.

SER. NO. 86-301,801, FILED 6-5-2014.

MARGARET POWER, EXAMINING ATTORNEY



*Michelle K. Lee*

Director of the United States  
Patent and Trademark Office

# United States of America

United States Patent and Trademark Office



**Reg. No. 4,802,068**

**Registered Sep. 1, 2015**

**Int. Cls.: 35 and 43**

**SERVICE MARK**

**PRINCIPAL REGISTER**

CBC RESTAURANT CORP. (DELAWARE CORPORATION)  
12700 PARK CENTRAL DRIVE, SUITE 1300  
DALLAS, TX 75251

FOR: RETAIL BAKERY SERVICES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 1-4-2007, IN COMMERCE 1-4-2007.

FOR: RESTAURANT AND CATERING SERVICES, IN CLASS 43 (U.S. CLS. 100 AND 101).

FIRST USE 1-4-2007, IN COMMERCE 1-4-2007.

OWNER OF U.S. REG. NOS. 2,597,050, 2,630,094 AND OTHERS.

THE COLOR(S) BLACK AND WHITE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BAKERY" OR "CAFE", APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF THE WORDS "CORNER BAKERY" IN WHITE LOWERCASE FONT CONTAINED WITHIN A HORIZONTAL BLACK RECTANGLE WITH A WHITE BORDER THAT HAS A CONVEX ARCH ABOVE THE CENTER OF THE PHRASE "CORNER BAKERY" AND A RECTANGULAR PROTRUSION BELOW THE CENTER OF "CORNER BAKERY" WITH THE WORD "CAFE" IN WHITE UPPERCASE LETTERS.

SER. NO. 86-301,775, FILED 6-5-2014.

MARGARET POWER, EXAMINING ATTORNEY



*Nichelle K. Lee*

Director of the United States  
Patent and Trademark Office

Int. Cl.: 42

Prior U.S. Cl.: 101

United States Patent and Trademark Office

Reg. No. 1,164,143

Registered Aug. 4, 1981

**SERVICE MARK**  
Principal Register

**THE CONTAINER STORE**

The Container Store, Inc. (Texas corporation)  
6081 Forest La.  
Dallas, Tex. 75230

For: RETAIL STORE SERVICES IN THE  
AREA OF HOUSEHOLD ACCESSORIES, STOR-  
AGE ITEMS, STORAGE SYSTEMS, AND  
SPACE ORGANIZERS, in CLASS 42 (U.S. Cl.  
101).

First use Jul. 1, 1978; in commerce Jul. 1, 1978.

Applicant disclaims the word "Store" apart from  
the mark as shown.

Ser. No. 209,963, filed Apr. 2, 1979.

J. C. DEMOS, Deputy Director

DAVID A. HERDMAN, Examiner

Int. Cl.: 42

Prior U.S. Cl.: 101

Reg. No. 1,481,139

**United States Patent and Trademark Office** Registered Mar. 15, 1988

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**SERVICE MARK  
PRINCIPAL REGISTER**

**THE FLY SHOP**

FLY SHOP INCORPORATED, THE (CALIFOR-  
NIA CORPORATION)  
4140 CHURN CREEK ROAD  
REDDING, CA 96002

FOR: RETAIL STORE AND MAIL ORDER  
SERVICES IN THE FIELD OF FISHING EQUIP-  
MENT, IN CLASS 42 (U.S. CL. 101).

FIRST USE 4-15-1978; IN COMMERCE  
12-15-1978.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "SHOP" , APART FROM THE  
MARK AS SHOWN.

SEC. 2(F).

SER. NO. 646,291, FILED 2-24-1987.

LAURIE WHITAKER, EXAMINING ATTOR-  
NEY

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Corrected

Reg. No. 2,256,604

Registered June 29, 1999

OG Date Jan. 16, 2001

**SERVICE MARK  
PRINCIPAL REGISTER**

**THE BODY SHOP**

THE BODY SHOP INTERNATIONAL PLC  
(UNITED KINGDOM COMPANY)  
WATERSMEAD PARK  
LITTLEHAMPTON, WEST SUSSEX BN17  
6LS, ENGLAND

OWNER OF U.S. REG. NOS. 970,931,  
1,666,465 AND OTHERS.

FOR: RETAIL STORE SERVICES AND  
MAIL ORDER CATALOG SERVICES FOR  
COSMETICS, TOILETRIES, SKIN CARE  
PREPARATIONS AND HAIR CARE PREP-  
ARATIONS; RENDERING TECHNICAL AID

AND ASSISTANCE IN THE ESTABLISH-  
MENT OF BUSINESSES AND RETAIL  
STORES SELLING COSMETICS,  
TOILETRIES, SKIN CARE PREPARATIONS  
AND HAIR CARE PREPARATIONS; PRE-  
PARING ADVERTISEMENTS AND PRO-  
MOTIONAL MATERIALS FOR  
FRANCHISEES, IN CLASS 35 (U.S. CLS. 100,  
101 AND 102).

FIRST USE 0-0-1973; IN COMMERCE  
0-0-1973.

SER. NO. 75-379,376, FILED 10-27-1997.

*In testimony whereof I have hereunto set my hand and  
caused the seal of The Patent and Trademark Office to  
be affixed on Jan. 16, 2001.*

COMMISSIONER OF PATENTS AND TRADEMARKS